

## REMARKS

Applicants respectfully submit that amendments made herein put this case in condition for allowance and that the original grounds for rejection were insufficient.

Applicants have clarified that the claims are directed to furniture that is for seating in the ordinary case, and not for articulated beds as shown in the two references cited by the Examiner in the April 30, 2004 Official Action. Moreover, applicants have further clarified that the pantographic style linkage serves to move the footrest between a vertical stowed position that is generally perpendicular to the seat portion of the furniture, and a fully extended position that is generally parallel to the seat portion, as well as intermediate positions. One of ordinary skill in the art finds support for these amendments in Figures 10 through 12, and in paragraphs 26 through 28 and 41 through 43 of the application. Neither U.S. Patent No. 5,568,661 to Bathrick, et al. ("Bathrick") nor U.S. Patent No. 5,072,463, to Willis ("Willis"), the cited references, teach or even suggest such movements of the footrest, as they appear physically incapable of accomplishing such movements.

In the April 30, 2004 Official Action, the Examiner rejected claims 14, 16 and 17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bathrick in view of the newly-cited Willis patent. The core argument put forth by the

Examiner in support of the rejection based on the combination of these two references is as follows:

Bathrick, et al., does not disclose a pantographic style linkage to facilitate movement of said footrest. However, Willis teaches in figures 7-9 a piece of motion furniture comprising, *inter alia*, a pantographic linkage 84 to facilitate movement of a footrest 14. ***Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Bathrick, et al., in view of the teachings of Willis to facilitate movement of said footrest with a pantographic linkage so as to facilitate said footrest to adjust from an elevated horizontal position to a retracted vertical position thus providing additional footrest positioning increasing the versatility of said piece of furniture, especially for providing easy access and exit from said furniture for a user.***

(Official Action at p. 2; emphasis added.)

In addition, the Examiner responded to arguments made by Applicants in their January 30, 2004 response to Official Action dated July 30, 2003, wherein the Examiner stated, among other things, "[t]he prosecution disclaimer made by applicant's counsel as arguments is afforded little weight when construing the claim language in the broadest reasonable interpretation. Any limitations argued to be in the claims must be fully set forth in the claims. Applicant cannot rely on counsel's arguments to limit the scope of the claims during prosecution."

Applicants respectfully submit that the Examiner is in error on both of these points and that Applicants have overcome the grounds for rejection in any event.

### Section 103

#### 1. Legal Standards For Obviousness

Applicants respectfully submit that the Examiner used a legally incorrect approach in combining Willis, a secondary reference, with Bathrick, as the primary reference, for § 103 purposes. There is no suggestion or motivation to combine these two references, and the courts have required Examiners to make an evidentiary showing on this point before combining prior art references is permitted. Moreover, Applicants respectfully submit that Bathrick expressly teaches away from combining Willis' pantographic style linkage with the rest of Bathrick's structure to facilitate movement of the footrest.

The U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") has made it clear that it is improper for an Examiner to find individual elements of a claim in prior art references, and then combine the references by simply declaring that it would have been obvious to make the combination. The Federal Circuit has termed this practice to be an improper entry into the "tempting but forbidden zone of hindsight" when analyzing the patentability of claims pursuant to § 103. The Federal Circuit has stated that "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). In carrying out the "rigorous application" of the "requirement" that Examiners show proof of a teaching or motivation to combine references, the Federal Circuit has required that Examiners present *an evidentiary basis* for the particular factual findings necessary to support the alleged suggestion, teaching or motivation to combine references.

In applying these requirements, and in reversing the Examiner and Board of Patent Appeals and Interferences ("Board"), the Federal Circuit held in *Dembiczak* that:

all of the obviousness rejections affirmed by the Board resulted from a combination of prior art references . . . . To justify this combination, the Board simply stated that 'the Holiday and Shapiro references would have suggested the application of . . . facial indicia to the prior art plastic trash bags.' However, *rather than pointing to specific information in Holiday or Shapiro that suggests the combination with the conventional bags*, the Board instead described in detail the similarities between the Holiday and the Shapiro references and the claimed invention, noting that one reference or the other – in combination with each other and the conventional trash bags – described all of the limitations of the pending claims. Nowhere does the Board *particularly* identify any suggestion, teaching, or motivations to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references . . . .

*In re Dembiczak*, 175 F.3d at 1000; emphasis added.

The Court went on to say that not only is "evidence of a suggestion, teaching or motivation to combine" required, but such evidence typically comes from the prior art references themselves ("the suggestion more often comes from the teachings of the pertinent references.") (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). *Dembiczak*, *supra*.

Of critical importance to the Federal Circuit is that the Examiner must cite to Independent *evidence* in support of an effort to combine references, and this *evidence* "must be clear and particular." *In re Dembiczak*, 175 F.3d at 999. "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *Id.*

In rejecting the Examiner's and Board's approaches, the Federal Circuit stated in *Dembiczak* that:

to the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention. For example, the Board finds that the Holiday bag reference depicts a "premanufactured orange" bag material, see *Dembiczak*, slip op. at 21, finds that Shapiro teaches the use of paper bags in various sizes, including "large", see *id.* at 22-23, and concludes that the substitution of orange plastic for the crepe paper of Holiday and the paper bags of Shapiro would be an obvious design choice, see *id.* at 24. Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. . . . Because we do not discern any finding by the Board that there was a suggestion, teaching or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand.

*Id.*

Similarly, in *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002), the Federal Circuit vacated a decision by the Board and the Examiner that found the various elements recited in the claims were collectively disclosed in several prior art references when combined. The Court did so where the Examiner and Board simply argued, without citing any specific evidence, that it would have been obvious to combine the individual elements and references:

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 U.S.P.Q. (BNA) 769, 775 (Fed. Cir. 1983). The essential

factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 U.S.P.Q. (BNA) 459, 467, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2D (BNA) 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

The factual inquiry whether to combine references must be "thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2D (BNA) 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2D (BNA) 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2D (BNA) 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2D (BNA) 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. (BNA) 929, 933 (Fed. Cir. 1984)).

***The need for specificity pervades this authority.*** See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. (BNA) 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the

reasoning by which the findings are deemed to support the agency's conclusion.

*In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002) (Emphasis added).

Here, the Examiner found that many of the elements of claims 14, 16 and 17 were found in the Bathrick reference, but he acknowledged that "Bathrick et al. does not disclose a pantographic style linkage to facilitate movement of the footrest." Official Action at p. 2. The Examiner then found this element was disclosed in Willis, when he stated that "Willis teaches in figures 7-9 a piece of motion furniture comprising, *inter alia*, a pantographic linkage 84 to facilitate movement of a footrest 14." It is at this juncture that the Examiner was required to cite to "clear and particular evidence" of some teaching or suggestion in the references or elsewhere to combine Willis with Bathrick. The Examiner has not cited that clear and particular evidence, however.

Instead, the Examiner has taken the existence of this element in the Willis reference as itself justifying the combination, when he stated the following immediately after the last quoted sentence:

***Therefore***, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Bathrick, et al., in view of the teachings of Willis to facilitate movement of said footrest with a pantographic linkage so as to facilitate said footrest to adjust from an elevated horizontal position to a retracted vertical position thus providing additional footrest positioning increasing the versatility of said piece of furniture, especially for providing easy access and exit from said furniture for a user.

*Id.* at p. 2. (Emphasis added.) No recitation is made of the "particular," "clear" "evidence" supporting the decision to combine the references. This is fatal to a



finding of obviousness under § 103. Applicants respectfully submit that the Examiner did not cite any such evidence because there is none for him to cite.

Just as importantly, the Federal Circuit has also stated that when prior art references can be shown to teach away from a combination, the claimed invention is likely to be non-obvious. In *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1350 (Fed. Cir. 2001), the Federal Circuit discussed this important legal principle:

The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. *Gambro Lundia A B v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999), limited in other grounds by *In re Gartside*, 203 F.3d 1305 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher).

\* \* \*

Perhaps *McGinley's* best argument to save his claims from prima facie obviousness in the light of *Pratt* and *Morgan* is his contention that those references together teach away from their combination. We have noted elsewhere, as a 'useful general rule,' that references that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). If references taken in combination would produce a 'seemingly inoperative device,' we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness. *In re Spinnoble*, 45 F.2d 578, 587 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); see

also, *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (inoperable modification teaches away)."

*McGinley*, 262 F.3d at 1354.

The meaning of the concept of "teaching away" was further explained in the case of *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). According to the Federal Circuit, "a reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend upon the particular facts; In general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the results sought by the applicant." *In re Gurley*, 27 F.3d at 553.

The Manual of Patent Examining Procedure ("M.P.E.P.") has incorporated these requirements of the law. For example, in M.P.E.P. § 2141, it is stated that "Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case." (Emphasis in original). The M.P.E.P. specifically indicates that "The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." M.P.E.P § 2142.

Section 2143.01 reiterates the criticality of the examiner citing evidence to meet the requirement that there be a suggestion or motivation to combine references. The M.P.E.P. states that the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness, and the fact that

the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. Instead, clear evidence of the motivation to make the combination is required. *Id.*

By carefully following the mandated legal requirements for a proper Section 103 analysis, and comparing those requirements against the Examiner's arguments set forth in the Official Action of April 30, 2004, it is seen that the required evidentiary basis for combining references was not provided, and in any event the references actually teach away from any combining of their structures.

Accordingly, the Examiner has not met his burden of identifying "clear and particular evidence" within the Bathrick reference or the Willis reference, or anywhere else, that demonstrates the suggestion or motivation to combine the pantographic style linkage of Willis with the remaining structure of Bathrick, to facilitate movement of the footrest. Moreover, as discussed below, the Bathrick and Willis references themselves teach away from making such a combination because it produces a seemingly inoperative device and because it is contrary to a main objective of the design in Bathrick.

## 2. The Cited References

While the Examiner argues that a person of ordinary skill in the art at the time of the invention would have taken the pantographic style linkage 84 of Willis, shown in figures 7-9, and placed that structure on the Bathrick design, he has not cited to evidence that this is so.

The Bathrick reference is entitled "Articulated Bed With Frame Mounted Power Module." As is seen from the drawings and description of Bathrick, the concept of an easily removable power module that permits easy and efficient packaging and shipping, as well as assembly and replacement, is a central object of the invention of Bathrick. In column 3, at lines 32-34, Bathrick indicates that "FIG. 4 is a partly exploded enlarged perspective of the power module assembly illustrated FIGS. 1 and 2." What Bathrick repeatedly emphasizes is that this power module assembly is a unit that is easily separated from the rest of the articulated bed for a variety of desirable purposes:

Another advantage in this power module is that it can be removed as a unit from the frame cross member for repair or replacement.

This unitary power module, i.e., the elongated housing containing the two drive motors, the two rocker shafts, the rocker arms and interconnecting gearing, offers the manufacturer a variety of marketing options without requiring disassembly of the power module. One option is the power module manufacturer can ship the power module fully assembled to the articulated bed manufacturer, frequently skilled in woodworking and to a limited extent welding, but not skilled in power drive systems. Such bed manufacturers would construct the wood planer mattress support and simply attach the power module to the cross frame member. No other interconnections would be required to complete the power module and frame assembly in operative cooperation. The articulated bed manufacturer then sells this completed assembly as a unit.

The advantage of the present articulated invention over that shown in our prior patent, is that the present design is an entire bed assembly that can be packaged for shipment to the ultimate user in three compact packages, one including the power module, one including the collapsed modified bed frame and "U" shaped cross members, and the final one containing the collapsed mattress support.

These three packages can be sent either directly to the consumer's home or can be shipped to distributors or to retail bedding operations.

See U.S. Patent No. 5,568,661 to Bathrick, see column 2, line 59 through column 3, line 20.

Bathrick makes reference to an earlier Bathrick patent, U.S. Patent No. 5,063,632, titled "Power Module for An Articulated Bed." ("Bathrick I"). See column 1, line 57 through column 2, line 9 of the cited Bathrick reference, U.S. Patent No. 5,568,661. One of the main features that differs between the earlier Bathrick I device (which is otherwise fairly similar to the device of the cited Bathrick reference) is that the power module in the earlier Bathrick I patent was actually fastened to the lower surface of the central stationary seat panel shown in FIG.2 of that patent. See also, FIG. 3 of Bathrick I.

The connection between the power module and the rest of the "articulated bed" of Bathrick I is described in Bathrick I as follows:

The power module 10 is more clearly illustrated in FIGS. 3, 4 and 5, and as seen in FIG. 3 the power module 10 includes an elongated rectangular housing having a bottom wall 42 a top wall 43 and side walls 44 and 45. These walls are formed from aluminum extrusions. The top wall 43 has flanges 46 and 47 that carry a plurality of bosses 49 that receive fasteners that connect the housing and the entire power module to the lower surface of the central stationary seat panel 15 as illustrated in FIG. 2.

Bathrick I, column 3, line 61 to column 4, line 2. In other words, the power module in Bathrick I is securely connected to the lower surface of the central, stationary support panel of the bed. In contrast, in the cited Bathrick reference, the power module is not securely connected to the bottom of the central

stationary section of the mattress support assembly (which connection seemingly interferes with the ease of attachment, removal, packaging and shipment), but instead the power module 16 rests on top of two "U-shaped" cross members 14 and 15 (it is secured to member 14 by means of an angle bracket 71, with fasteners 73, attached to power module housing wall 72, as shown in FIGS. 3 and 4), and the top side 75 of the power module 16 (see FIG. 4) provides added support to the underside 76 of the mattress support central panel 42 (see FIGS. 1 and 2) through unsecured contact. As the cited Bathrick reference goes on to explain it:

In accordance with the present invention an articulated bed having a modified standard bedframe is provided that supports an independent power module replaceable without disassembly from the frame.

\* \* \*

After the frame is assembled in the home, a pair of "U" shaped cross members are attached across the frame and the power module is affixed to the tops of these cross members.

\* \* \*

An important aspect of the present invention is the housing for the drive module provides the sole pivotal support for the two rocker shafts. As noted above these rocker shafts have been previously journaled inside frame members that require the drive module and the side frame members to be shipped as a unit from the manufacturing location to assembly location or from assembly to ultimate purchaser, because frequently the receiving party cannot technically provide the proper assembly. With the present module, final set up is reduced and the power module can be shipped in a much smaller container in its completely assembled form.

\* \* \*

Another advantage in this power module is that it can be removed as a unit from the frame cross member for repair or replacement.

\* \* \*

The advantage of the present articulated invention over that shown in our prior patent, is that the present design is an entire bed assembly that can be packaged for shipment to the ultimate user in three compact packages, one including the power module, one including the collapsed modified bed frame and "U" shaped cross members, and the final one containing the collapsed mattress support.

See U.S. Patent No. 5,568,661 to Bathrick, column 2, line 15 through column 3, line 20.

Thus, there is little doubt that a central objective of the cited Bathrick reference, and one of the ways it was different from the earlier Bathrick I patent, is that the power module in the cited patent, which drives the movement of the articulated bed, is meant to be an easily removable module that can be attached and removed at home, quickly and simply, by relatively unsophisticated users of the bed. Thus, it is seen in the cited Bathrick reference that design changes were specifically made to the Bathrick I device to minimize the number of discreet parts, their connections, their complexity, as well as the ease of packaging for shipment and the ease of assembly upon arrival at the home of a customer. These express objectives of the cited Bathrick reference are at odds with any motivation to move "backwards" by changing the Bathrick design to now include a more complicated, physically secured pantographic style linkage as shown in Willis.

Bathrick also cites to another relevant patent in its disclosure beside the earlier Bathrick I patent. U. S. Patent No. 4,381,571 to Elliott ("Elliott") is discussed in column 1 of the cited Bathrick reference. Bathrick says the following about Elliott:

A primary consideration in the design of articulated beds and components therefore in the residential market is ease of shipment because a container the size of an entire assembled articulated bed would not only be excessively large but too heavy for a single delivery person to bring into the home to install.

One attempt at solving this problem is illustrated in the Elliott U.S. Pat. No. 4,381,571 which shows an articulated mattress spring that is adapted to fit on top of and rest on a separate simple rectangular bed frame. ***The Elliott mattress frame includes large stationary "L" shaped side sections with cross members to provide support for axially oriented motor and screw assemblies that drive complicated four bar linkages at the four corners of the module that serve to raise and lower the head and leg sections of the mattress support. While Elliott suggests that these parts, numbering literally hundreds, may be disassembled for shipment it is realistically not practical to have the purchaser reassemble this complex device in his or her home.***

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Furthermore in the Elliott device the power module with drive motors, gearing and rocker shafts, requires that the rocker shafts be mounted in outboard bearings, i.e. bearings in the large rectangular frame described above and such outboard bearings denigrate the capability of shipping the bed in easily carried containers without requiring any significant reassembly at the purchaser's location.

Bathrick, as noted in the highlighted part above, specifically points to Elliott's use of "complicated four bar linkages" at the four corners of the power



module that serve to "raise and lower" the head *and leg sections* of the mattress support. In other words, Bathrick is specifically distinguishing his disclosure and invention as teaching away from a prior art reference that teaches "pantographic style linkage" used to facilitate movement of the footrest. See the Elliott reference, items 74, 76, 56 and 68 of FIG. 2, and items 74, 76, 104 and 105 of FIG. 3, discussed generally in column 2, lines 32 to 59; column 3, lines 3 through 15; column 4, line 50 to column 5, line 18; and column 5, line 31 to column 6, line 20.

Since the cited Bathrick patent goes to some length to distinguish the disclosure in the Elliott patent, a patent disclosing a pantographic style linkage system, and since Bathrick does so specifically because that style of secured connection with the footrest interferes with major objectives of Bathrick - - namely, simplicity; ease of assembly and disassembly; ease of packing and shipment; and a minimum number of components - - , it is apparent that Bathrick teaches away from a person skilled in the art looking to Willis (or Elliott) for the addition of pantographic style linkage to facilitate movement of the footrest. In the language of the Federal Circuit's binding precedent, Bathrick would "discourage" a person of ordinary skill in the art "from following the path set out in [Willis]." *In re Gurley*, 27 F.3d at 553.

Further, there is nothing about the Bathrick patent's disclosure that suggests that there are limitations on the ability to move the unnumbered component that the Examiner contends is the analog to the footrest of the present claims, such that one of skill would be looking to overcome that

shortcoming by employing Willis' pantographic style linkage. Since there was no shortcoming that was apparent in Bathrick, there was no motivation to look for a structure to solve any problems, where that motivation might have led to the Willis reference's pantographic style linkage system.

Additionally, the pantographic style linkage of Willis produces a seemingly inoperative product if placed on the Bathrick device, as suggested by the Examiner. FIG. 1 of Bathrick shows four panel sections 62, 42, 86 and unnumbered (to the right of 86). It is this last panel (unnumbered) that Applicants understand the Examiner to consider a footrest. However, it is clear that the four panels all rest above the upper side of angle iron side rails 20 and 21 of bed frame assembly 12, above the horizontal portion 23 shown in FIGS. 2 and 3. Thus, contrary to the Examiner's contention, by placing the Willis analog to the pantographic style linkage onto the Bathrick device, the footrest could not effectively come to "a retracted vertical position," as the Examiner contends. The last, unnumbered panel is too long when compared to panel 86, and even if it weren't too long, it cannot swing below the horizontal plane defined by the horizontal portion 23 of the side rails. The fact that the alleged footrest panel of Bathrick rests above these horizontal portions of the side rails means that the panel cannot swing through and below that same plane of the side rails. Nor could the footrest, if it was made the same length as panel 86, provide a working product where the footrest was "retractable to a vertical position" (the Examiner's contention) since in that case panel 86 and the footrest would *both be back-to-back and vertical*, above the side rails (as they are connected by a pivoting

hinge). Such an unnatural position would almost certainly make the bed unusable since there would be (i) a tilted, back support panel, (ii) a horizontal central portion to support a user's buttocks, and (iii) a vertical, two-sided panel portion at the area near the user's buttocks/leg junction, a structure that clearly would interfere with the product's ordinary intended use. Consequently, such a combination would not be pursued as it appears to create an essentially inoperative device.

It is also apparent that there is no motivation to combine Willis with Bathrick that is found anywhere in the Willis reference, and that Willis, too, teaches away from such a combination. The Willis disclosure indicates in the Summary of the Invention that "a preferred embodiment of this invention comprises a bed with five basic positions and being infinitely variable between those positions. These positions include the normal sleeping position, the head raised above the legs, the legs raised above the head, sitting position and standing (i.e., for transfer to a walker, or for walking)." Willis, column 1, lines 47-54. It is apparent that these multiple positions are accomplished through the use of two electric motors which are physically connected to the foot support by way of drive mechanisms, brackets and rods. See, generally, column 3, line 5 to line 66. By reviewing the pantographic style linkage set forth in Willis, it is apparent that Willis accomplishes these various movements because the power source of Willis (i.e., the motors) is physically joined to "pantographic arrangement 84", as shown in for example FIG. 9 and as described in Willis' specification:

Motor 48 is mounted on segment 18 and is connected  
by way of a drive mechanism 74 to an arm 76 connected

to and extending from segment 16 as more clearly seen in FIGS. 8 and 9. Mechanism 74 comprises a rod 78 extending from a cylinder 82 having a similar arrangement as just described for effecting the extension and retraction of rod 78 depending on the direction of rotation of motor 48.

It will also be noted that there is a pantograph arrangement 84 connecting segments 14 and 18. Arrangement 84 comprises a pair of rods 86 on opposite sides of segment 18 as also seen in FIG. 12, joined to a pair of rods 88 pivoted at one end on segment 14 and the other end on one end of each of rods 86. Shaft 45 passes through rods 86 and as previously indicated is supported on each end by side boards 22 and 24. Platform 12 in effect pivots about shaft 45. Thus, as seen in FIG. 8, when electric motor 48 is energized to extend rod 78 and rotate segment 16 through its arm 76, pantograph arrangement 84 will cause segment 14 to rise as illustrated.

When electric motor 46 is energized to extend rod 56, segment 18 will be rotated counterclockwise around shaft 45 producing the configuration shown in FIG. 9. By extending rod 56 still further, then bed 10 will put the patient in a sitting position as shown in FIG. 5.

U.S. Patent No. 5,072,463 to Willis, column 3, lines 27 through 52. Since Willis discloses that the way in which its pantographic style linkage facilitates movement of the foot portion is by direct physical fixed connection between the power source and the described rods, shafts, segments, mechanisms and pantograph arrangement, Willis actually teaches away from employing that same pantograph style structure in a setting such as Bathrick, because as noted above an important object of Bathrick's disclosure is to minimize the number of fixed connection points between its power module 16 and the rest of the articulated bed. Thus, one of ordinary skill who is reviewing Willis would also be

discouraged from following a path to employ its pantographic style linkage on the device of Bathrick.

Between (1) the Examiner's inability to cite "clear and specific" evidence of some suggestion to combine Willis with Bathrick; (2) the lack of any motivation to search out a way to facilitate movement of the footrest portion of Bathrick when it already moves appropriately by the power module disclosed therein; (3) the Bathrick reference's explicit teaching away from the use of complicated, fixed pantographic style linkages that impede ease of assembly and disassembly, packing, shipment and replacement (such as those disclosed in Willis and Elliott); and (4) the Bathrick product becoming seemingly inoperative if one were to attempt to attach to Bathrick's articulated bed a pantographic linkage system like that shown in Willis, to facilitate movement of the footrest, there is simply no sound legal or evidentiary basis for combining the references relied upon the Examiner. Accordingly, the Applicants respectfully request that the outstanding rejection of claims 14, 16 and 17 be reconsidered and withdrawn, and that a Notice of Allowance thereafter be issued.

**B. Prosecution Disclaimers Are Recognized**

The Examiner also found that the arguments of counsel during prosecution are given little weight, and are insufficient to provide a limitation on the meaning of the claims, when the Examiner is generally required to give claims the broadest reasonable interpretation during prosecution.

In *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed. Cir. 2003), the Federal Circuit once again found that prosecution disclaimers can serve to limit claim scope. ("Where the patentee has unequivocally disavowed a certain meaning to obtain his patent, the doctrine of prosecution disclaimer attaches and narrows the ordinary meaning of the claim congruent with the scope of the surrender."). Nothing about the cases finding this doctrine applicable have required that the disclaimer be by way of introduction of a new claim limitation. In fact, it appears to apply when a patent applicant disclaims during prosecution a particular meaning to an existing limitation. In *Spectrum Int'l v. Sterilite Corp.*, 164 F.3d 1372, 1378 -79 (Fed. Cir. 1998), the Federal Circuit strongly supported the availability of prosecution disclaimers, as follows:

In determining the proper meaning of the claims, "we first consider the so-called intrinsic evidence, i.e., the claims, the written description, and, if in evidence, the prosecution history." *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1347, 47 U.S.P.Q.2D (BNA) 1418, 1424 (Fed. Cir. 1998). Moreover, "if upon examination of this intrinsic evidence the meaning of the claim language is sufficiently clear, resort to extrinsic evidence, such as treatises and technical references, as well as expert testimony when appropriate, should not be necessary." *Id.*

Unambiguous intrinsic evidence in turn provides sufficient input to the rules of claim construction, in particular in this case, the rule that explicit statements made by a patent applicant during prosecution to distinguish a claimed invention over prior art may serve to narrow the scope of a claim. See *Southwall Techs. Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576, 34 U.S.P.Q.2D (BNA) 1673, 1676 (Fed. Cir. 1995) ("The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution."); *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 452, 227 U.S.P.Q. (BNA) 293, 296 (Fed. Cir. 1985)

(stating that the prosecution history, which includes "all express representations made by or on behalf of the applicant to the examiner to induce a patent grant," limits the interpretation of the claims "so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance"). n2

n2 Our recourse to language emphasizing the relinquishing of subject matter during prosecution should not be construed to undermine the "clear distinction between following the statements in the prosecution history in defining a claim term, and the doctrine of prosecution history estoppel, which limits expansion of the protection under the doctrine of equivalents when a claim has been distinguished over relevant prior art." *Southwall*, 54 F.3d at 1578, 34 U.S.P.Q.2D (BNA) at 1679 (citing *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 862, 20 U.S.P.Q.2D (BNA) 1252, 1262 (Fed. Cir. 1991)).

That explicit arguments made during prosecution to overcome prior art can lead to narrow claim interpretations makes sense, because "the public has a right to rely on such definitive statements made during prosecution." *Digital Biometrics*, 149 F.3d at 1347, 47 U.S.P.Q.2D (BNA) at 1427 (pointing to "notice [as] an important function of the patent prosecution process, as reflected by the [patent] statute itself"). Indeed, "by distinguishing the claimed invention over the prior art, an applicant is indicating what the claims do not cover." *Ekchian*, 104 F.3d at 1304, 41 U.S.P.Q.2D (BNA) at 1368. Therefore, a patentee, after relinquishing subject matter to distinguish a prior art reference asserted by the PTO during prosecution, "cannot during subsequent litigation escape reliance [by the defendant] upon this unambiguous surrender of subject matter." *Southwall*, 54 F.3d at 1581, 34 U.S.P.Q.2D (BNA) at 1681; *Ekchian*, 104 F.3d at 1304, 41 U.S.P.Q.2D (BNA) at 1368 (citing *Southwall*). Accordingly, "claims may not be construed one way in order to obtain their allowance and in a different way against accused infringers." *Southwall*, 54 F.3d at 1576 (citing *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1562, 19 U.S.P.Q.2D (BNA) 1500, 1504 (Fed. Cir. 1991)); see also *Alpex Computer Corp. v. Nintendo Co. Ltd.*, 102 F.3d 1214, 1221, 40 U.S.P.Q.2D (BNA)

1667, 1672 (Fed. Cir. 1996) ("Therefore, because Alpex admitted during prosecution that its claims do not cover a video display system based on shift registers as in Okuda . . . Alpex's claims cannot now be construed to cover the [accused device], which possesses the same structural and functional traits as Okuda."). This principle applies with equal force to arguments made by a patentee to sustain the patentability of claims during reexamination. See, e.g., *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 532, 41 U.S.P.Q.2D (BNA) 1001, 1007 (Fed. Cir. 1996) ("We also believe the district court correctly interpreted the prosecution history to require that the 'perforation means' limitation cannot be construed to include ultrasonic bonded seams. Cole surrendered ultrasonic bonded seams in her requests for reexamination.").

Thus, Applicants respectfully submit that their prior prosecution disclaimer is sufficient for its intended purpose.

Finally, Applicants disagree with the Examiner's contention that they must prove what a claim limitation such as motion furniture does *not* cover – the Applicants believe that the specification, drawings and claims at issue clearly define the invention. The patents submitted in response to the prior Official Action comprise positive evidence of what those skilled in the art understand the term "motion furniture" to mean. The Examiner has not cited any legal authority that patent applicants must further cite "negative" evidence – showing what claim terms do not mean. This is particularly the case when, as here, a clear disclaimer has already been made of record describing the claim term "motion furniture" as not embracing beds.

Applicants further disagree that persons of ordinary skill in the art believe that a chair or other seating device is a bed. If one places a pillow and cover on a dining room table, that does not make the dining room table into a bed, to a



person of ordinary skill in the art – it still is a dining room table. Similarly, the fact that a reclining chair can be slept on does not make the reclining chair lose its inherent character as a chair.

C. Conclusion

For all of the foregoing reasons, Applicants respectfully request that the amendments be entered herein and that, as amended, the claims are in condition for allowance. Alternatively, Applicants respectfully submit that the grounds for rejection set forth by the Examiner do not meet his burden for a proper rejection under 35 U.S.C. § 103, and on this ground Applicants also respectfully request that claims 14, 16 and 17 be allowed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Leland P. Schermer". The signature is fluid and cursive, with a large initial "L" and a stylized "S".

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